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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,086	10/30/2003	Ronald H.P. Brus	2578-6158US	9184
24247	7590	09/22/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			LUCAS, ZACHARIAH	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,086

Applicant(s)

BRUS ET AL.

Examiner

Zachariah Lucas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to methods for determining if a compound affects a life phase of a virus, classified in class 435, subclass 5.
 - II. Claims 17, 21, and 22, drawn to methods for determining if two compounds affect the life phases, each in different virus, classified in class 435, subclass 5.
 - III. Claims 18-20, drawn to methods for determining the absence of a compound on a phase of a viral life cycle, classified in class 435, subclass 5.

If the Applicant elects Group I above, the Applicant is further required to elect under 35 U.S.C. 121 one of each of the following subinventions:

- i) one of the viruses identified in claim 13,
- ii) either the adenovirus early protein from early region 1 or early region 2, and
- iii) one of the following methods of determining the effect of a compound on the viral life cycle:
 - (a) examining a cellular protein's activity;
 - (b) examining a cellular protein's amount;
 - (c) examining the interaction of the virus with the cell;
 - (d) examining the virus' activity;
 - (e) examining the amount of the virus;
 - (f) examining the activity of a viral fragment;
 - (g) examining the amount of a viral fragment; or
 - (h) examining the cell's viability.

If the Applicant elects Group II above, the Applicant is further required to elect under 35 U.S.C. 121 one of each of the following subinventions:

- i) two of the viruses identified in claim 13,
- ii) either the adenovirus early protein from early region 1 or early region 2, and
- iii) one of the methods identified in iii) above.

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If the Applicant elects Group III above, the Applicant is further required to elect under 35 U.S.C. 121 one of each of the following subinventions:

- i) one of the viruses identified in claim 13,
- iii) one of the following methods of determining the effect of a compound on the viral life cycle:
 - (a) examining a cellular protein's activity;
 - (b) examining a cellular protein's amount;
 - (c) examining the interaction of the virus with the cell;
 - (d) examining the virus' activity;
 - (e) examining the amount of the virus;
 - (f) examining the activity of a viral fragment;
 - (g) examining the amount of a viral fragment; or
 - (h) examining the cell's viability.

If the Applicant elects Group III, the Applicant is additionally required to elect one of subinventions (A) or (B). Each of these subinventions represents the elected group wherein the absent compound is (A) a natural constituent of the cell, or B) a natural constituent of the virus.

The inventions are distinct, each from the other because of the following reasons:

2. The subinventions of each of subgroups i, ii, and iii for the Groups of inventions above are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d). In the instant case, each of the subinventions has a separate utility in the claimed methods of determining the effect of the presence or absence of a compound on a virus. The inventions are therefore distinct.

3. The inventions of subgroups A and B of Group III above are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions relate to methods that have different modes of operation (i.e. the removal of a different compound) and that have different functions

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(determine the effects of the absence of a different compound). The inventions are therefore distinct.

4. The inventions of Groups I and II are related as combination and subcombinations.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination comprises elements that may be relied on for patentability other than the subcombination. Each of the claimed methods has utility in determining the effects of compounds on a virus.

5. The inventions of Groups I, II, and IV and the invention of Group III are unrelated.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions relate to methods that perform different functions and have different modes of operation. The methods of Groups I, II, and IV involve the presence of a compound to be tested, whereas the methods of Group III involve the absence of a compound normally present. The inventions are therefore distinct.

Election of Species

6. Claim 3 is generic to a plurality of disclosed patentably distinct species comprising individual species of virus from each of the identified families of virus, examples of which are

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identified in paragraph [0040] of page 10 of the application. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even if this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

7. Because these inventions are distinct for the reasons given above, and because the searches required for any one of the groups is not coextensive, and requires searches not required for, the others, restriction for examination purposes as indicated is proper.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

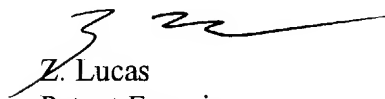
9. It is here noted that some of the restrictions requirements made above fall within the scope of PTO Linking claim practice. In accordance with this practice as described in MPEP 809.03, linking claims will be considered with the elected invention. If the elected invention is found allowable, the linking claim will also be examined. If no substantive rejection is found for the linking claim, the restriction among the Groups it comprises will be withdrawn.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Z. Lucas
Patent Examiner


9/20/04

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